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10/822,567	04/12/2004	Jimmie D. Burrow	125447-1005	2641
7590 09/02/2008 MICHAEL E. MARTIN GARDERE WYNNE SEWELL LLP 1601 ELM STREET, SUITE 3000 DALLAS, TX 75201				
EXAMINER HIGGINS, GERARD T				
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1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/822,567

**Applicant(s)**

BURROW ET AL.

**Examiner**

GERARD T. HIGGINS

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 07/06/2004
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: on page 2, line 5, please correct the patent number for US Patent No. 5,961,150.

Appropriate correction is required.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Please limit the abstract to 150 words.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 28, the fact that merely "applying energy" can be used to bond the image sheet to said flexible member is not properly supported in the specification.

***Claim Objections***

4. Claim 30 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 29 states that said member is both flexible and indentable; however, claim 30 seeks to broaden this by stating the plastic material forming said member is only flexible.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 27-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 27, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render

a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 27 recites the broad recitation "an article of manufacture," and the claim also recites "such as a folder...memo pad and the like" which is the narrower statement of the range/limitation.

Regarding claim 27, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

With further regard to claim 27, the phrase "to be formed as" in the fifth line of the claim is so unclear as to render the claim indefinite. It appears as if the article requires the image sheet and therefore it is unclear how said flexible member could "be formed as...said article."

Claim 27 recites the limitation "said article" in the sixth line of the claim. There is insufficient antecedent basis for this limitation in the claim. Perhaps applicants mean "said article of manufacture."

Claim 27 recites the limitation "said sheet of flexible material" in the ninth through the sixteenth lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

With regard to claim 29, the phrase "said article comprising" in the second line of the claim renders the claim indefinite because a portfolio can comprise an article but the article cannot comprise the portfolio etc.

With regard to claim 29, applicants state they have a "cover part formed of a flexible and indentable material" and "a member formed of said flexible and indentable material and comprising at least a portion of said cover part;" however, these statements render the claim confusing and indefinite as it appears there are either two cover parts or two flexible and indentable materials.

With further regard to claim 29, the phrase "at a second and opposite side of said image sheet" is so unclear as to render the claim indefinite. Perhaps applicants are referring to the contact region being "at a second and opposite side of said first side."

With even further regard to claim 29, the claim seeks to say that "said member having a planar indentation formed therein while bonding said image to said member *in said planar indentation.*" This is unclear and indefinite because it seeks to state that a second indentation is formed while bonding said image to said member in a first indentation. It is clear from applicants' specification that the only one planar indentation is formed in the bonding process.

With even further regard to claim 29, the phrases "having a depth at least as great as the thickness of said image sheet" and "so as to recess said image sheet in said member" are conflicting limitations, and thereby render the claim indefinite. If the depth is at least as great as the thickness of said image sheet that includes a situation

where the image sheet is coplanar with the non-indented sections of said member; therefore, the image sheet would not be recessed.

Claim 33 recites the limitation "said coating" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 33 is also confusing since it appears as if the embossing should be on the coating and not under the coating, as is disclosed in the specification.

Claim 34 recites the limitation "said image" in the fourth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "said laminate sheet" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With regard to claim 37, the phrase "said article comprising" in the second line of the claim renders the claim indefinite because a portfolio can comprise an article but the article cannot comprise the portfolio etc.

With regard to claim 37, applicants state they have a "cover part formed of a flexible and indentable material, said article further comprising;" however, this renders the claims confusing and indefinite as it appears there are either two cover parts or two flexible and indentable materials.

With further regard to claim 37, the phrase "adapted to be bonded" in the ninth and tenth lines of the claim renders the claim indefinite. It appears as if applicants are claiming a formed article, and therefore it is unclear if the image sheet is being claimed as a separate article within the same claim.

The term "substantially planar" in claim 37 is a relative term which renders the claim indefinite. The term "substantially planar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how planar the indentation must be to be substantially planar.

With even further regard to claim 37, the term "at least about equal" is so confusing and unclear as to render the claim indefinite. This phrase appears to contradict itself.

Claim 37 recites the limitation "said indentation" in the sixteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With regard to claim 38, the phrase "said article comprising" in the second line of the claim renders the claim indefinite because a portfolio can comprise an article but the article cannot comprise the portfolio etc.

With regard to claim 38, applicants state they have a "cover part formed of a flexible and indentable material, said article further comprising;" however, this renders the claims confusing and indefinite as it appears there are either two cover parts or two flexible and indentable materials.

The term "substantially planar" in claim 38 is a relative term which renders the claim indefinite. The term "substantially planar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how planar the indentation must be to be substantially planar.



With further regard to claim 38, the phrase "debossed indentation *on* said member" is so unclear as to render the claim indefinite. It is clear from applicants' specification that the indentation is formed *in* said member.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

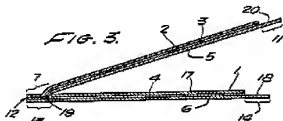
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 37 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jones (3,153,868).

The Examiner notes various product-by-process limitations in applicants' claims 37 and 38; specifically, the entire sequence of connecting the image sheet and the member, the fact that the image is printed on the image sheet, and also that the image sheet is bonded to the member using RF radiation. It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any resulting article that has the same structure as applicants’ claims will be held to anticipate, or alternatively, render obvious applicants’ claims.

With regard to claims 37 and 38 Jones discloses the device of Figure 3.

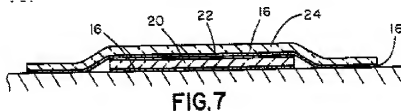


The device is a protected label, which can be used as a luggage tag. The device is comprised of a member 2 and 3, a transparent film sheet which is clearly flexible as seen in Figure 3 and an image sheet 1, which is made of paper, another flexible material (col. 1, line 60 to col. 2, line 38). Clearly when this laminate has been sealed after peeling of the layer 5 and subsequent bonding of the layers 2 and 3 onto the layer 1 and the backing layer 6 the member layer 2 and 3 will have a substantially planar indent or debossment of a thickness that is about equal to the thickness of the image sheet 1, which is identical to that claimed. The Examiner deems that the adhesive of Jones will form a bond analogous to applicants’ bonding by RF radiation.

10. Claims 27, 28, 37, and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ambridge et al. (6,224,110) as evidenced by Jensen et al. (4,857,129).

The Examiner notes various product-by-process limitations in applicants' claims 27, 28, 37, and 38; specifically, the entire sequence of connecting the image sheet and the member, the fact that the image is printed on the image sheet, and also that the image sheet is bonded to the member using RF radiation. It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any resulting article that has the same structure as applicants' claims will be held to anticipate, or alternatively, render obvious applicants' claims.

With regard to claims 27, 28, 37, and 38, Ambridge et al. disclose the device of Figure 7.



The device is a label, and therefore it may be used as a luggage tag. It is comprised of a flexible and indentable member **24** and an image sheet or flexible sheet of plastic

material **20**, which is the same material as the portion **24** (col. 2, lines 2-54). Clearly from the Figure the member **24** has a substantially planar debossed indentation that is at least equal to the thickness of the image sheet **20**. The image sheet is bonded to the member in the indentation. The Examiner deems that the adhesive **16** of Ambridge et al. will form a bond analogous to applicants' bonding by RF radiation or by applying energy.

Alternatively, the Examiner takes official notice that bonding using RF radiation is well-known in the art of bonding plastic materials as evidenced by Jensen et al., and hence it would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the image sheet and the member with both adhesive and RF energy. The motivation to do so would be to provide a bonded material that was less likely to delaminate.

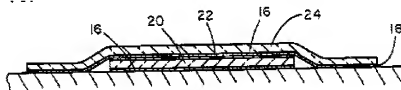
### ***Claim Rejections - 35 USC § 103***

11. Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ambridge et al. (6,224,110) as evidenced by Jensen et al. (4,857,129).

The Examiner notes various product-by-process limitations in applicants' claims 29 and 31; specifically, the entire sequence of connecting the image sheet and the member, the fact that the image is printed on the image sheet, and also that the image sheet is bonded to the member using RF radiation. It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any resulting article that has the same structure as applicants’ claims will be held to anticipate, or alternatively, render obvious applicants’ claims.

With regard to claims 29 and 34, Ambridge et al. disclose the device of Figure 7.



**FIG. 7**

The device is a label, and therefore it may be used as a luggage tag. It is comprised of a flexible and indentable member **24** and an image sheet or flexible sheet of plastic material **20**, which is the same material as the portion **24** (col. 2, lines 2-54). Clearly from the Figure the member **24** has a substantially planar debossed indentation that is at least as great as the thickness of the image sheet **20**. The image sheet is bonded to the member in the indentation with the image side (first side) **22** facing the member. The substrate to which the member and image sheet is attached is a laminate sheet covering said image (please see Figure 7); however, Ambridge et al. fail to disclose that the second face, opposite of the image side (first face), is the side bonded to the member **24** and that the substrate is a transparent laminate sheet.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the orientation of the image sheet **20** such that the

image side (first side) **22** was not the side contacting the member **24**. It would have equally been obvious to one having ordinary to make the image seen from either side, which therefore means it would have been obvious to make the substrate to which this label was attached was also transparent. The end use of the device would dictate which side one would want to see the image; and clearly one could expect predictable results by merely reversing the orientation of the image sheet **20** and making the substrate transparent.

With regard to claim 30, the image sheet **20** and the member **24** are apart of the label stock, which is a flexible plastic material (col. 2, lines 3-6).

With regard to claim 31, the Examiner deems that the adhesive **16** of Ambridge et al. will form a bond analogous to applicants' bonding by RF radiation.

Alternatively, the Examiner takes official notice that bonding using RF radiation is well-known in the art of bonding plastic materials as evidenced by Jensen et al., and hence it would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the image sheet and the member with both adhesive and RF energy. The motivation to do so would be to provide a bonded material that was less likely to delaminate.

With regard to claim 32, the opaque layer **22** is an ink-receptive coating (col. 2, lines 11-27).

With regard to claim 33, the surface of the image sheet **20** under the ink receptive coating has **a** texture; furthermore, so does the top surface of the ink receptive coating, as well as every other surface in the device of Ambridge et al.

12. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ambridge et al. (6,224,110) as evidenced by Jensen et al. (4,857,129) as applied to claim 34 in view of Jones (3,153,868).

Ambridge et al. renders obvious all of the limitations of applicants' claim 34 in section 11 above; however, they fail to disclose that the label stock material (image sheet) and the applied substrate/laminate sheet may be comprised of polyvinyl chloride.

Jones discloses that the label stock material may be comprised of polyvinyl chloride (col. 4, lines 1-5).

Since Ambridge et al. and Jones are both drawn to label materials; it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the label stock/image sheet out of polyvinyl chloride. The motivation to do so is because polyvinyl chloride is well known for providing excellent chemical resistance; furthermore, the Examiner deems that one of ordinary skill would have clearly envisaged PVC as the "substantially clear plastic material" of Ambridge et al.

With regard to the fact of making the substrate material out of polyvinyl chloride, the Examiner deems this limitation to be a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Clearly, providing a PVC material on either side of the image sheet would provide excellent chemical resistance of the images printed on the image sheet; furthermore, since the Examiner has already deemed it to have been

obvious to apply the label to a transparent substrate, polyvinyl chloride would be an obvious choice to be that transparent substrate due to its chemical resistance properties.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner has cited other label structures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 7:30am-5pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins, Ph.D.  
Examiner  
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